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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,293	04/02/2004	David A. Arias	0101457	2303

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EXAMINER

MILLER, BENA B

ART UNIT PAPER NUMBER

3712

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,293

Applicant(s)ARIAS, DAVID A. **Examiner**

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 19, 21, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the claim recites an improper Markush grouping. Note, the phrase "comprises at least one of" should read -- consisting of --. Further it is not clear, what is considered to be an equivalent of the recited fabric portions.

Claim 19 contains the trademark/trade name Styrofoam. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a foam and, accordingly, the identification/description is indefinite.

Art Unit: 3712

Regarding claims 19 and 21, it is not clear as to what is encompassed by the phrase "any other known or later developed material or system capable of providing a determined level of relatively weight to the aquatic toy".

Regarding claims 27 and 28, it is not clear what is encompassed by the phrases "at least one optional buoyancy element" and "at least one optional weight element". It is not clear whether the buoyancy and the weight element are claimed. The limitation recites optional, which means "Left to choice."¹ In this instance, the examiner presumes that the buoyancy and weight element are claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 11-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Quello.

Regarding claims 1, 27 and 28, Quello teaches in the figures a fabric portion (20; the examiner takes the position that the plastic sheeting of Quello is a naturally weighted material), at least one hollow opening (col. 1, lines 56-60), a frame pocket

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Art Unit: 3712

(fig.1, col. 1, lines 52-54), a frame member (fig.1), at least one optional buoyancy element (10) and at least one optional weight element (36) .

Regarding claim 2, Quello further teaches a general object in figure 1.

Regarding claim 3, as best as understood, Quello further teaches an equivalent in figure 1 and col. 1, line 48.

Regarding claim 4, Quello further teaches multiple materials (20, 22).

Regarding claims 5-7, the examiner considers the features of claims 5-7 to be inherent in fabric portion of the toy of Quello.

Regarding claim 8, the examiner takes the position that the frame member is capable of being removed for the aquatic toy.

Regarding claims 11-13 and 16, the claims are a product by process to a frame member.

Regarding claim 14, Quello further teaches a general overall geometry of an other shape (fig.1).

Regarding claim 15, Quello further teaches the frame member retained withing the frame pocket (fig.1).

Regarding claims 17, 18, 20 and 22, Quello further teaches a buoyancy and a weight (36) provided to the toy (10); fig.1).

Regarding claim 19, Quello further teaches a styrofoam buoyancy element (col. 1, lines 30-31).

Art Unit: 3712

Regarding claims 23-26, Quello further teaches at least one additional fabric portion (22), the fabric portion extending downward and upward from the upper and lower portion of the hollow opening (fig. 1) and the fabric portion is weighted (63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quello.

Quello teaches in the figures most of the elements of the claimed invention except for a corrosion resistant material and multiple frame member segments and multiple frame pocket fragments. It would have been considered a mere design choice for the material of Quello to be corrosion resistant for the purpose of providing a stable and durable frame member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the frame member of Quello corrosion resistant for the purpose of having a stable and durable frame member.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to having multiple frame member segments and multiple frame pocket fragments, since it has been held that mere duplication of the

Art Unit: 3712

essential working parts of the a device involves only routine skill in the art. At. Regis
Paper Co. v. Bemis Co. 193 USPQ 8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. Wallingford, Henry, Weitzman, Ray, Baird, Alexander, Wickham,
and Butler.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Bena Miller whose telephone number is 703.305.0643.
The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).


Bena Miller
Examiner
Art Unit 3712

bbm
September 06, 2004